

Application No. 09/410,494
Amendment dated June 5, 2006
Response to Office Action of January 5, 2006

Atty. Docket No. 74451.P107
Examiner Won, Young N.
TC/A.U. 2155

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 13 and 25 have been amended. Claims 26-29 and 32-34 were previously canceled. No claims have been added or canceled in this amendment. Thus, claims 1-25, 30, 31 and 35-37 are pending.

CLAIM REJECTIONS – 35 U.S.C. § 102(e)

Claims 1-7, 9, 10, 12-19, 21, 22, 24, 25, 30, 31 and 35-37 were rejected as being anticipated by U.S. Patent No. 6,370,527 B1 issued to Singhal (*Singhal*). For at least the reasons set forth below, Applicants submit that claims 1-7, 9, 10, 12-19, 21, 22, 24, 25, 30, 31 and 35-37 are not anticipated by *Singhal*.

Claim 1 recites:

generating, automatically with an electronic device without user intervention, a private local network search request in response to an original search request, the local network search request to cause a search to be performed on electronic documents stored by a device that is part of a private local network, the private local network making the documents available to electronic devices belonging to an organization corresponding to the electronic device and not available to remote electronic devices not corresponding to the organization, and further wherein one or more of the documents are saved in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents, the search of the electronic documents on the local network to be performed according to search parameters of the original search request;

generating, automatically with the electronic device without having to wait for a search result of the local network search request from the local network and in addition to the local network search request, an external network search request in response to the original search request, the external network search request to cause a search to be performed on electronic documents available from devices that are part of an external

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public network via a network portal of an external network according to the search parameters of the original search request; and
generating a single search report at the electronic device based on the search results of the private local network search request and the public external network search request.

Thus, Applicants claim in response to a single original search request, generating a *private* local network search request of documents accessible only to electronic devices belonging to an organization *and* an external *public* network search request, with the results of the *private* local network search and the external *public* network search presented as a single search report. Claim 13 is drawn to a machine-readable medium and recites similar limitations. Claim 25 also searches on a private local network and a public external network in response to a single search request.

The January 5, 2006 Office Action states:

The applicant(s) argue that *Singhal* only discloses a single network and not a local and external network.

See page 10. This is a mischaracterization of the previously submitted arguments. While *Singhal* discloses multiple network types, *Singhal* clearly does not disclose that at least one of the networks is a private network in which documents available to electronic devices belonging to an organization corresponding to the electronic device and not available to remote electronic devices not corresponding to the organization. The claims have been amended to more clearly designate the meaning of a private network.

Specifically, the cited section of *Singal* states:

The network 120 may be any type of network that is capable of sending and receiving communication signals. For example, network 120 may be a data network, such as the Internet, an intranet, a local area network (LAN), a wide area network (WAN), and the like. The network 120 may also be a telecommunications network, such as a local telephone network, long distance telephone network, cellular telephone network,

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satellite communications network, and the like. Furthermore, the network 120 may include a plurality of data networks, a plurality of telecommunications networks, a combination of data and telecommunications networks and the like.

See col. 3, lines 15-29. Noting in the definition of network provided by *Singhal* provides the public-private designation as recited in the claims.

Singhal merely discloses Internet searches by multiple Internet portals (c.g., AltaVista, Lycos, HotBot, Excite). See Figure 2. The results of the searches performed by these portals are integrated into a single search report. See Figure 6. However, these Internet portals search publicly available Internet and World Wide Web documents and none of these searches is directed to a private network in as claimed. Therefore, *Singhal* cannot anticipate the invention as claimed in claims 1, 13 and 25.

Claims 2-7, 9, 10, 12 depend from claim 1. Claims 14-19, 21, 22 and 24 depend from claim 13. Claims 30, 31 and 35-37 depend from claim 25. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-7, 9, 10, 12, 14-19, 21, 22, 24, 30, 31 and 35-37 are not anticipated by *Singhal* for at least the reasons set forth above.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 11 and 23 were rejected as being unpatentable over *Singhal* in view of U.S. Patent No. 5,913,040 A issued to Rakavy, et al (*Rakavy*). For at least the reasons set forth below, Applicants submit that no combination of *Singhal* and *Rakavy* can teach or suggest the invention as claimed in claims 11 and 23.

Claim 11 depends from claim 1 and claim 23 depends from claim 13. *Rakavy* is cited to teach a search report having an advertisement selected based on the search

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results. See page 8 of the Final Office Action. However, whether or not *Rakavy* discloses the selection of advertisements, *Rakavy* does not cure the deficiencies of *Singhal* set forth above. Therefore, no combination of *Singhal* and *Rakavy* can teach or suggest the invention as claimed in claims 11 and 23.

Claims 8 and 20 were rejected as being unpatentable over *Singhal* in view of U.S. Patent No. 6,263,332 B1 issued to Nasr, et al (*Nasr*). For at least the reasons set forth below, Applicants submit that no combination of *Singhal* and *Nasr* can teach or suggest the invention as claimed in claims 8 and 20.

Claim 8 depends from claim 1 and claim 20 depends from claim 13. *Nasr* is cited to teach a search report as either HTML or XML. See page 9 of the Final Office Action. However, whether or not *Nasr* discloses HTML and/or XML search results, *Nasr* does not cure the deficiencies of *Singhal* set forth above. Therefore, no combination of *Singhal* and *Nasr* can teach or suggest the invention as claimed in claims 8 and 20.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-25, 30, 31 and 35-37 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present

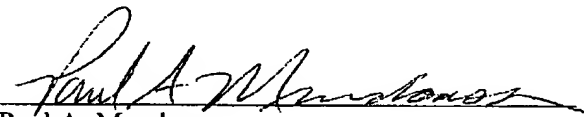
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application. Please charge any shortages and credit any overcharges to our Deposit
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Respectfully submitted,
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